

REMARKS

Claims 8-18, and 21-26 are pending. Claim 8 has been amended above and new claims 23-26 have been added. No new matter has been added by way of the above amendments. For example, the amendment to claim 8 is supported by the present specification at page 17, lines 8-19. New claim 23 is supported by the present specification at, for example, page 3, lines 21-23 and page 6, lines 10-13. New claim 24 is supported by the present specification at page 6, lines 10-13. Lastly, new claims 25 and 26 are supported by the present specification at page 8, lines 14-18. Accordingly, no new matter has been added.

In view of the following remarks Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 102(b)

The Examiner has rejected claims 8, 11 and 16 under 35 U.S.C. § 102(b) asserting that these claims are anticipated by Applicants own statements in the present specification at page 4, line 25 to page 5, line 4. Applicants respectfully traverse.

Applicants disclosure at the indicated area of the specification recites as follows:

Theanine, formulated in the theanine-containing composition of the present invention, is a glutamic acid derivative contained in tea-leaves, which is the main component of deliciousness (umami) of tea. It is also used as a food additive for seasoning.

In the outstanding Office Action the Examiner uses this disclosure to support an assertion that theanine is a known major component in tea and is known to be used as a food additive. The Examiner further asserts that drinking tea is well known in this country and some of the people who drink tea are suffering from PMS. Thus, the Examiner asserts that the present method claims are anticipated. Applicants respectfully submit that the Examiner's reasoning is flawed.

In support of the above rejection, the Examiner quotes In re Swinehart, which states "it is elementary that the mere recitation of al newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." 169 USPQ 226, 229 (CCPA 1971). This quotation is misapplied by the Examiner.

In re Swinehart deals with the use of functional claim language to claim a composition by what it does rather than by what it is, a practice which is perfectly acceptable in the USPTO.

In stark contrast, Applicants are claiming a method of using a composition. This is an important distinction.

Compositions containing theanine may be known in the art, however, Applicants are not attempting to claim a composition containing theanine. Rather, Applicants are claiming a method of using a composition containing theanine. The particular elected species is a use in treatment of premenstrual syndrome (PMS), a use hitherto unpracticed and unknown in the art.

"[A] process patent can only be anticipated by a similar process." Carnegie Steel Co. v. Cambria Iron Co., 185 U.S. 403, 424 (1902). The Examiner's reliance on the fact that compositions containing theanine were known in the art is insufficient to anticipate claims directed to methods of treating an individual in need of suppressing or ameliorating symptoms accompanying PMS, comprising administering a composition comprising theanine. This insufficiency cannot be cured by the Examiner's tenuous reasoning that some people drinking tea must have been suffering from PMS. There is no evidence that compositions comprising theanine were administered to treat women suffering from symptoms of PMS. Thus, the Examiner's anticipation rejection is improper and should be withdrawn.

Moreover, Applicants draw the Examiner's attention to the fact that the present claims do not encompass drinking tea, rather the claims relate to the administration of a composition comprising theanine prepared by mixing theanine with other ingredients. Thus, in order to expedite prosecution, the presently claimed method does not encompass the consumption of tea. Applicants hereby reserve the right to file a continuation application containing claims not excluding the consumption of tea as a method of treating PMS.

Based on the above comments, it evident that no anticipation exists. Reconsideration and withdrawal of this rejection are respectfully requested.

Issues Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 8, 11, 16-18, 21 and 22 under 35 U.S.C. § 103(a) as being obvious over "Applicants own admission" in view of Wu et al., and Yokoyama et al. Applicants respectfully traverse this rejection.

The Examiner asserts that the presently claimed theanine/mineral composition would have been obvious. However, Applicants respectfully submit that the cited references neither disclose nor suggest such a composition. First, the prior art

fails to suggest or disclose the administration of the presently claimed composition to treat symptoms of PMS, as discussed above. Second, the secondary references of Wu et al. and Yokoyama et al. simply disclose the addition of certain minerals to tea leaves during the growth of the tea leaves in order to increase production of theanine. This is completely unrelated to the addition of minerals to a composition containing theanine. Thus, the Examiner has failed to present a valid *prima facie* case of obviousness. Reconsideration and withdrawal of this rejection are requested.

The Examiner has also rejected claims 8, 11, 16-18, 21 and 22 under 35 U.S.C. § 103(a) as being obvious over Fujii et al. (JP 406100442 A) in view of Brown et al., Dinning et al., and Woods et al. Applicants respectfully traverse this rejection.

The primary reference of Fujii discloses a composition referred to as an anti-stress composition. However, the anti-stress composition referred to in Fujii is based simply upon the lowering of an elevated heart rate by administering isoproterenol, or the lowering of elevated blood pressure and heart rate by applying a stress load of calculation operation. That is, Fujii discloses at paragraph [0018]:

"It is clear from the Examples described below that the L-theanine used in the present invention suppresses

the elevation of heart rate when isoproterenol, which is an agonist for adrenergic β -receptor, is administered to rats. Also, as shown in the evaluation examples described below, the beverage of the present invention suppresses elevation of blood pressure and heart rate by applying a stress load caused by calculation operation."

Fujii provides no information that such a lowering of blood pressure or heart rate is effective in the treatment of PMS. Thus, at least one major deficiency exists in the primary Fujii reference. The secondary references of Brown, Dinning and Woods fail to cure the deficiency of the primary Fujii reference. In fact, none of the secondary references of Brown, Dinning or Woods discloses a relationship between stress and the severity of PMS, much less a teaching of whether or not PMS may be treated by suppressing stress. Accordingly, when the prior art references of Fujii, Brown, Dinning and Woods are taken in combination with each other, the presently claimed subject matter is not made *prima facie* obvious as contended by the Examiner. Thus, the Examiner is respectfully requested to withdraw this rejection and allow the currently pending claims.

In view of the above, Applicants respectfully submit that the present claims define subject matter which is patentable over the cited art. Thus, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions concerning this

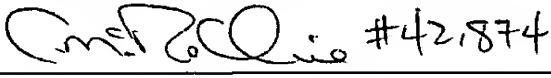
application, he is requested to contact Craig A. McRobbie,
Registration No. 42,874 at the offices of Birch, Stewart, Kolasch
& Birch, LLP.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a),
the Applicants hereby petition for an extension of two (2) months
to August 20, 2001 in which to file a reply to the Office Action.
The required fee of \$390.00 is enclosed herewith.

If necessary, the Commissioner is hereby authorized in this,
concurrent, and future replies, to charge payment or credit any
overpayment to Deposit Account No. 02-2448 for any additional fees
required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17;
particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version with Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 8 has been amended as follows:

8. (Amended) A method for treating an individual in need of suppressing or ameliorating a symptom accompanying diminished homeostasis, comprising:

administering a composition comprising theanine to the individual in need thereof,

wherein said composition is prepared by a method comprising a step of mixing theanine with other ingredients.

Claims 23-26 have been added.